

REMARKS

The Examiner rejected claims 56-60 and 62-87, while withdrawing claims 88-106 from further consideration. Thus, claims 56-60 and 62-106 are pending.

Claims 56-60 and 62-88 have been amended herein to recite a membrane penetrating needle. In addition, claim 88 has been amended herein to replace the characterized by language with comprising language. Applicants' specification fully supports these amendments. Thus, no new matter has been added.

In light of these amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 56-60 and 62-87. Applicants also respectfully request rejoinder, examination, and allowance of claims 88-106.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 56-60 and 62-87 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of the Henderson reference (U.S. Patent No. 3,064,651) and the Hickey reference (U.S. Patent No. 2,697,438) alone or in combination with one or more of the following references: the Haindl reference (U.S. Patent No. 4,889,529), the Bittner reference (U.S. Patent No. 5,515,871), the Kaneko reference (U.S. Patent No. 6,517,523).

Applicants respectfully disagree. A person having ordinary skill in the art would not have combined the teachings of the Henderson and Hickey references as the Examiner has done. The Henderson reference is directed to a hypodermic needle that penetrates tissue without cutting. For example, column 1, lines 45-49 disclose that:

An object of the present invention has, therefore, been to provide a hypodermic needle which is devised to **prevent** excision of skin fragments or other tissue without impairing the capability of the needle to perform its intended function.

(Emphasis added). In addition, column 2, lines 40-44 disclose that:

when a needle so constructed is employed, the point 12 penetrates the tissue **without cutting**; and as the rear edge portion of the bore opening encounters said tissue any intruding or pressed-in portion thereof will be rolled outwardly by the rounded surface **instead of being severed or sheared off**.

(Emphasis added). Likewise, the Hickey reference is directed to a hypodermic needle that does not core tissue. For example, column 1, lines 18-22 disclose that:

An object of the invention is to provide a **non-coring** needle which permits and does not restrict the free passage of fluid through the pointed end into and out of the lumen of the needle or passageway through the cannula.

Thus, a person having ordinary skill in the art reading the Henderson and Hickey references would have understood that these references disclose two different types of hypodermic needles for avoiding tissue coring. In addition, there is no logical reason why a person having ordinary skill in the art reading the Henderson and Hickey references and setting out make a hypodermic needle that avoids tissue coring would modify the needles of Henderson or Hickey as the Examiner appears to contend for the simple reason that the hypodermic needles of both Henderson and Hickey already avoid tissue coring.

Moreover, a person having ordinary skill in the art reading the Henderson and Hickey references would have understood from the Hickey reference that the non-coring advantages of the Hickey needle is attributed to the combination of surfaces 8 and 10 and the axial location of the penetrating point. In fact, column 2, lines 39-42 disclose that:

The advantages of the needle point are attributed to the combination of the curvature of the surface 8, 10, 10 with the axial location of the penetrating point.

Thus, a person having ordinary skill in the art who was somehow motivated to combine the teachings of the Henderson and Hickey references certainly would not have replaced surfaces 8 and 10 of Hickey's needle with the rounded edges of Henderson's needle for the simple reason that Hickey specifically discloses that it is the combination of the point location and surfaces 8 and 10 that result in the non-coring advantages of Hickey's needle.

Taken together, the combinations of cited references do not render the presently claimed membrane penetrating needles obvious.

In light of the above, Applicants respectfully request withdrawal of the rejections of claims 56-60 and 62-87 under 35 U.S.C. § 103(a).

Applicant : Peter Kinast et al.
Serial No. : 10/542,823
Filed : July 24, 2006
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Attorney's Docket No.: 19497-0002US1 / P16657US01

CONCLUSION

Applicant asserts that claims 56-60 and 62-87 are in condition for allowance, which action is respectfully requested. In addition, Applicants respectfully request rejoinder, examination, and allowance of claims 88-106. The Examiner is invited to telephone the undersigned attorney if such contact would expedite prosecution of this Application. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: August 13, 2010

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